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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,915	11/16/2001	Steven E. Meier	44781-00100	5479
22904	7590	09/30/2004	EXAMINER	
LOCKE LIDDELL & SAPP LLP 600 TRAVIS 3400 CHASE TOWER HOUSTON, TX 77002-3095			STORK, KYLE R	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,915

Applicant(s)

MEIER ET AL.

Examiner

Kyle R Stork

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response the application filed 16 November 2001.
2. Claims 1-20 are pending. Claims 1, 13, and 17 are independent claims.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: System and process for managing text and image documents with a database.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7, 14, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per dependent claim 7, the applicant claims "automated scanner instructions."
However, automated scanner instructions are not disclosed in the specification.

As per dependent claim 14, the applicant claims a "web server." However, a web server is not disclosed in the specification.

As per dependent claim 16, the applicant claims a "web server." However, a web server is not disclosed in the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-12 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per independent claim 1, the applicant discloses the a process for managing documents. The steps listed by the applicant describe coding consistent with the applicant's specification on page 5. However, the applicant further discloses the process "wherein the process occurs without manual coding (claim 1, line 8)." The claim is indefinite because it does not specify how the limitations in claim 1 differ from the coding as described on page 5.

Dependent claims 2-12 are rejected based upon their dependence on claim 1.

As per dependent claim 12 the applicant discloses "the process wherein the contribution to the database is..."

However, these claims are dependent upon dependent claim 11 which discloses a process "which further comprises the step of allowing users to search the database, save search results of the database, view images from the database, request prints of images, or contribute to the database over a wide area network."

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Since claim 11 is written in the alternate format, the process may allow any of the element steps, not necessarily the "contribute to the database over a wide area network" step. Therefore, the applicant cannot have a dependent claim based upon a step that is not required. This renders claims 12 indefinite.

As per dependent claim 19 the applicant discloses "the method wherein redacting..."

However, these claims are dependent upon dependent claim 18 which discloses a method "which further comprises annotating, redacting, printing, printing a batch of images, saving information to the database, managing different versions of an image or text entries, customizing record information, or collaborating with additional users over the wide area network."

Since claim 18 is written in the alternate format, the method may allow any of the choices to be present, not necessarily the "redacting" option. Therefore, the applicant cannot have a dependent claim based upon a step that is not required. This renders claims 19 indefinite.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-4, 6, 8-9, 11-13, 15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau et al. (US 5319745) in further view of Bach et al. (US 6628808).

As per independent claim 1, Vinsonneau discloses the process for managing documents which comprises the step of:

- Recognizing text in each image (column 1, lines 33-36; column 4, lines 34-63)
- Extracting text to form a text file (column 1, lines 33-36; column 4, lines 34-63; column 10, lines 45-49)
- Using the text file to form an inventory of every word (column 1, lines 33-36; column 4, lines 64-68)

Wherein the process occurs without manual coding. Vinsonneau fails to disclose verifying the text file which comprises the sub steps of generating an adjustable score threshold and scoring each text file to determine if the text file exceeds the score threshold. However, Bach discloses verifying the text file which comprises the sub steps of generating an adjustable score threshold and scoring each text file to determine if the text file exceeds the score threshold (column 4, lines 38-48).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau's process of character recognition and text inventory with Bach's process of verifying each file, since it would have allowed a user to obtain a text file from an image that does not contain a clean separation between background and foreground elements (Bach: column 4, lines 5-11: Here, Bach

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describes the problems that are presented when there is not a clean separation between elements. This is the problem that Bach overcomes with his/her invention).

As per dependent claim 2, Vinsonneau and Bach disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Vinsonneau further discloses the process which prior to the step of recognizing text in each image, further comprises the steps of:

- Scanning each document to form an image (column 5, lines 22-25)
- Assigning a unique number to each (column 4, lines 14-22)

As per dependent claim 3, Vinsonneau and Bach disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Vinsonneau further discloses the process which after the step of using the text file to form an inventory of every word, further comprises the step of forming a database wherein the database comprises:

- Each image
- Each text file
- The text inventory (column 10, lines 45-54)

As per dependent claim 4, Vinsonneau and Bach disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Bach further discloses the process which further comprises the step of correcting text files that fail to exceed the adjustable score threshold (column 11, line 55- column 12, line 8).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's method of file

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verification with Bach's method of file correction, since it would have allowed a user to correct the file and then attempt to perform operations upon the file.

As per dependent claim 6, Vinsonneau and Bach disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Vinsonneau further discloses the process wherein the text file is a separate file tethered to the image (column 10, lines 45-54).

As per dependent claim 8, Vinsonneau and Bach disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Bach further discloses the process which further comprises the step of changing the resolution of at least one image (column 11, line 55- column 12, line 6: Here, modifying the intensity of the image is the same as changing the resolution).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's method of scanning documents to produce images with Bach's method of changing the resolution of at least one image, since it would have allowed a user to have an image that would more easily have text extracted due to the different intensities between portions of the image (Bach: column 4, lines 5-11).

As per dependent claim 9, Vinsonneau and Bach disclose the limitation similar to those in claim 3, and the same rejection is incorporated herein. Vinsonneau further discloses the limitation which further comprises the step of allowing users to access the database via a wide area network (Figure 3: Here, a user workstation (10) is connected to the network (20), which is further connected to the database (5)).

As per dependent claim 11, Vinsonneau and Bach disclose the limitations similar to those in claim 9, and the same rejection is incorporated herein. Vinsonneau further discloses the process further comprising the step of allowing users to search the database, save search results of the database, view images from the database, request prints of images, or contribute to the database over a wide area network (column 10, lines 50-57).

As per dependent claim 12, Vinsonneau and Bach disclose the limitations similar to those in claim 11, and the same rejection is incorporated herein. Vinsonneau further discloses the process wherein a contribution to the database is an annotation, a redaction, a folder creation, a creation of record, a designation of privilege, an online collaboration, or an image upload (column 10, lines 50-57).

As per independent claim 13, Vinsonneau discloses a system for managing documents comprising:

- Extraction software capable of extracting text from images to form text files (column 1, lines 33-36; column 4, lines 34-63)
- Text indexing software capable of indexing each text file to form an inventory (column 1, lines 33-36; column 4, lines 64-68)
- A file server capable of containing each image and the text inventory (Figure 3: Here, the databases act as file servers, in that they return files to a computer over a network)

Vinsonneau fails to disclose verification software capable of scoring each text file to determine if the text file exceeds an adjustable score threshold. However, Bach

discloses verification software capable of scoring each text file to determine if the text file exceeds an adjustable score threshold (column 4, lines 38-48).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau's system of character recognition and text inventory with Bach's system of verifying each file, since it would have allowed a user to obtain a text file from an image that does not contain a clean separation between background and foreground elements (Bach: column 4, lines 5-11: Here, Bach describes the problems that are presented when there is not a clean separation between elements. This is the problem that Bach overcomes with his/her invention).

As per dependent claim 15, Vinsonneau and Bach disclose the limitations similar to those in claim 13, and the same rejection is incorporated herein. Vinsonneau discloses the system further comprising a scanner capable of scanning the documents to form the images (column 5, lines 22-25).

As per independent claim 17, Vinsonneau and Bach disclose a method of using a system for managing documents, wherein the system comprises at least on server containing a database having images and a text inventory created from extracted and verified text layer exceeding an adjustable scored threshold from each image accessible via a wide area network, the method which comprises the steps of:

- Accessing via the wide are network (Vinsonneau: Figure 3; column 17, lines 24-28)
- Searching the inventory via the wide area network (Vinsonneau: Figure 3; column 17, lines 24-28; column 17, lines 43-46)

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As per dependent claim 18, Vinsonneau and Bach disclose the limitations similar to those in claim 17, and the same rejection is incorporated herein. Vinsonneau discloses the method further comprising annotating, redacting, printing, printing a batch of images, saving information to the database, managing different version of an image or text entries, customizing record information, or collaborating with additional users over the wide area network (Figure 3; column 17, lines 24-28).

10. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau and Bach in further view of Egger et al. (US 5832494).

As per dependent claim 5, Vinsonneau and Bach disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Vinsonneau and Bach fail to specifically disclose the process further comprising the step of mapping text positions in relation to the image. Egger discloses the process further comprising the step of mapping text positions in relation to the image (column 28, lines 3-5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's method of generating text files with Egger's method of mapping, since it would have allowed a user to have and edit a text file with the same format and style as the image file it was created from.

11. Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau and Bach in further view of Keene et al. (US 6650433).

As per dependent claim 7, Vinsonneau and Bach disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Vinsonneau and Bach fail to disclose the process further comprising the step of inserting sheets

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containing specific automated scanner instructions between at least two documents prior to the step of scanning each document to form each image. However, Keene discloses scanning instructions (column 12, lines 17-21).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's process of text recognition with Keene's process of scanning instructions, since it would have allowed the user to apply the instructions to the scanned pages.

12. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau and Bach in further view of Steen, III et al. (US 6510350).

As per dependent claim 10, Vinsonneau and Bach disclose the limitations similar to those in claim 9, and the same rejection is incorporated herein. Vinsonneau and Bach fail to disclose the process further comprising the step of establishing access levels. However, Steen discloses the process further comprising the step of establishing access levels (column 7, line 66- column 8, line 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's process of allowing user access to a network with Steen's process of establishing access levels, since it would allow only allow specified users access to the database.

13. Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau and Bach in further view of Wesinger, Jr. et al. (US 6052788).

As per dependent claim 14, Vinsonneau and Bach disclose the limitations similar to those in claim 13, and the same rejection is incorporated herein. Vinsonneau and Bach further disclose a database server capable of accessing the file server (Vinsonneau: Figure 3). Vinsonneau and Bach fail to disclose a web server capable of accessing a wide area network, a first firewall that is located between the web server and the database server, and a second firewall that is located between the database server and the file server. However, Wesinger discloses first firewall that is located between the web server and the intranet, and a second firewall that is located between the servers (Figure 1; Figure 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's system of accessing information with Wesinger's method of placing firewalls between servers to secure information, since it would have allowed a user to have information moved securely between servers on the wide area network.

14. Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau, Bach, and Wesinger in further view of Steen.

As per dependent claim 16, Vinsonneau, Bach, and Wesinger disclose the limitations similar to those in claim 14, and the same rejection is incorporated herein. Vinsonneau, Bach, and Wesinger disclose the system comprising at least one user interface capable of connection to the wide area network (Vinsonneau: Figure 3). They fail to disclose accessing the web server in a customizable secure environment.

However, Steen discloses accessing the web server in a customizable secure environment (column 7, line 66- column 8, line 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau, Bach, and Wesinger's system for accessing the web server through an interface with Steen's method of accessing the web server in a customizable secure environment, since it would have allowed a user to protect information stored on the web server from other users lacking the same clearance.

15. Claim 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau and Bach in further view of Rackman (US 5903646).

As per dependent claim 19, Vinsonneau and Bach disclose the limitations similar to those in claim 18, and the same rejection is incorporated herein. Vinsonneau and Bach fail to disclose the method wherein redacting alters both an image and corresponding portions of the text layer and the text inventory associated with the image. However, discloses the method wherein redacting alters both an image and corresponding portions of the text layer and the text inventory associated with the image (column 2, lines 53-59).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's method of managing documents with Rackman's method of altering both the image and text since it would allow a user to have consistency between the two layers.

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16. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Vinsonneau and Bach in further view of CVS (checkout—Check out sources for editing and commit—Check files into the repository).

As per dependent claim 20, Vinsonneau and Bach disclose the limitations similar to those in claim 17, and the same rejection is incorporated herein. Vinsonneau and Bach fail to specifically disclose:

- Downloading a portion of the database on a user computer while connected to the system via the wide area network
- Accessing and modifying the portion while not connected
- Synchronizing the modifications to the database once reconnected to the system via the wide are network

However, CVS discloses:

- Downloading a portion of the database on a user computer while connected to the system via the wide area network (checkout: paragraph 3)
- Accessing and modifying the portion while not connected (checkout: paragraph 3)
- Synchronizing the modifications to the database once reconnected to the system via the wide are network (commit: paragraph 2)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Vinsonneau and Bach's method of managing documents with CVS method of downloading, modifying, and updating, since it would

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have allowed a user to make changes to documents without being continually connected to the wide area network.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Egger et al. (US 6233571): Discloses indexing, searching, and displaying.
- Pandit (US 5859636): Discloses recognition and operation on text data.
- Driscoll (US 5642502): Discloses searching for documents using relevancy rankings.
- Aref et al. (US 6662180): Discloses searching in large databases.
- Leone, Jr. et al. (US 6600482): Discloses image processing.
- Hertz et al. (US 636669): Discloses bar code recognition.
- Haran (US 6072461): Discloses document generation.
- Smith et al. (US 5880451): Discloses bar code decoding.
- Stolfo (US 5668897): Discloses image processing and data compression for image databases.
- Yeh et al. (US 6125194): Discloses image processing.
- Scanlon (US 5850480): Discloses OCR error correction.
- Rivette et al. (US 5809318): Discloses a method and apparatus for displaying and manipulating text and image documents.

- Ogawa et al (US 5608874): Discloses a system and method for data file format translation.
- Storch et al. (US 5548110): Discloses optical error-detection and correction.
- Anstin (US 4013876): Discloses a document scanning and printing system and method.
- Rivette et al. (US 5799325): Discloses a system and method for generating text files.
- Haigh, Susan "Optical Character Recognition (OCR) as a Digitization Technology": Discloses OCR.

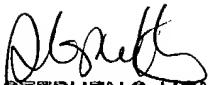
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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